

REMARKS

Claims 1-37 are pending in the present application. Claims 1, 15, and 25 are independent.

Statutory Double Patenting Rejection

Claims 15 and 21-22 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 and 7-8, respectively of co-pending Application No. 09/916,367. Claims 1-4, 16-20, 25-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8, and 13-16, respectively of co-pending Application No. 09/916,367. These rejections are respectfully traversed.

Applicant finds this double patenting rejection rather curious and contradictory. On the one hand, the Examiner has admitted that there is a substantial difference between the claims of the related co-pending application and the present application. Indeed, the Examiner also applies an obviousness-type double patenting rejection as to many of the claims of the present application relative to the same co-pending application to which the statutory double patenting rejection is applied.

More particularly, the Examiner admits in the obviousness-type double patenting rejection that the conflicting claims are different in that the claims in the instant application adjust the

decision threshold of an optical receiver based on a total percentage error indicator while the related co-pending application utilizes a relative percentage error indicator to adjust receiver threshold. The Office Action then goes on to state that this difference would have been obvious to one of ordinary skill in the art.

The Examiner is reminded that to construct a double patenting rejection (of either the statutory or non-statutory variety) the claims of the related application serve as a disclosure against which the claims of the instant application are compared. Any differences between the relative claim sets should be recognized and evidence provided as to why such a difference is considered obvious to one of ordinary skill in the art. Such evidence must include a teaching as to the different features and some showing of motivation to combine the evidence of that feature with the disclosure provided by the other claim set.

This procedure was not followed and the Examiner has failed to establish a *prima face* case of statutory double patenting in particular. Indeed, there is no discussion, evidence or any persuasive arguments as to why the claims of the present application are considered the same invention as that recited in the noted co-pending application. Indeed, there is no exact correspondence between these two claim sets a fact which apparently

recognized in the obviousness-type double patent rejection but conveniently ignored in the statutory double patenting rejection.

Applicant strenuously challenges the statutory double patenting rejection. The relative claim sets utilize completely different equations in order to set the threshold for an optical receiver. Specifically, the claims of the instant application calculate a total percentage error indicator based on the error signal and adjusts the decision threshold of the optical receiver in response to the total percentage error indicator. This is variously recited in the apparatus and method claim formats but the point is that a completely different calculation (total percentage error indicator) is performed and that the decision threshold of the optical receiver is adjusted based on this calculation.

In sharp contrast, the related application calculates a completely different equation. Namely, the related application calculates a relative percentage error indicator and adjusts the decision threshold based on or in response to the relative percentage error indicator which is a very different value than the total percentage error indicator utilized by the presently claimed invention. The Office Action offers no evidence as to why these two different calculations and adjustments based on the results of the calculation are seen as the same invention. The Office Action is completely insufficient as to the statutory double patenting

rejection and Applicant vehemently challenges any reapplication of statutory double patenting to reject the present application.

Although Applicant does not agree with the obviousness-type double patenting rejection particularly because there is no evidence as to why the calculation of a total percentage error indicator is obvious in view of the relative percentage error indicator. There is no evidence in the Office Action that either of these calculations is known in the art. The only disclosure of these calculations is that which is found in the instant specification. It appears the Examiner is using hindsight reconstruction to reject the present claims. Such hindsight reconstruction is improper as has been decided numerous times by the Federal Circuit.

Although Applicant also challenges the obviousness-type double patenting rejection, Applicant is willing to submit a Terminal Disclaimer, particularly because a Terminal Disclaimer has no effect on patent term since both this application and the related application were filed on the same date of July 27, 2001. The submission of this Terminal Disclaimer clearly overcomes the obviousness-type double patenting rejection. Therefore, for all of the above reasons, taken alone or in combination, Applicant respectfully requests reconsideration and withdrawal of the obviousness-type double patent rejection.

Applicant also strenuously challenges and requests reconsideration and withdrawal of the statutory double patenting rejection.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael R. Cammarata (Reg. No. 39,491) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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